

REMARKS

Claims 20-23 and 38-71 are pending, with claims 20, 38, 39, 49, 69 and 70 being independent. Claims 20-23, 38, 39, 49, and 61 have been amended, and claims 68-71 have been added. No new matter has been added.

The Examiner has objected to claims 44, 45, 54, and 55 as introducing new matter. Specifically, the Examiner was not able to find support for the recited tube defining a lumen to receive the endoscope. Applicants submit that the recited tube may be, for example, the insertion tube 28 shown in Figs. 1 and 3 and described in the specification at least on page 5, lines 14-20 and page 5, line 35 to page 6, line 3. Accordingly, applicants request reconsideration and withdrawal of this objection.

Independent claims 20 and 38, along with their dependent claims 21, 59, and 61, have been rejected as being anticipated by Kagawa (U.S. Patent No. 5,163,433). Claims 22 and 23, which depend from claim 20, have been rejected as being unpatentable over Kagawa.

Claim 20, as amended, recites introducing fluid into a distensible organ. Kagawa describes an apparatus 1 defining a water supply passage 25 through which water is fed into a body cavity. See col. 6, line 66 to col. 7, line 5. However, Kagawa does not describe or suggest that the body cavity is a distensible organ.

For at least this reason, applicants request reconsideration and withdrawal of the rejection of claim 20 and its dependent claims 21-23 and 59.

Claim 38, as amended, recites "discharging fluid with detached tissue along a first path terminating at a first path source of suction, and discharging substantially only fluid along a second path terminating at a second path source of suction, said second path being completely separate from said first path."

Kagawa describes a first suction passage 21, which the Examiner equates to the recited first path, and a second suction passage 26, which the Examiner equates to the recited second path. See col. 7, lines 1 to 39. Rather than being completely separate, suction passage 21 and suction passage 26 merge together via first and second suction tubes 16 and 30 before terminating at suction pump 41. See Fig. 1; col. 6, lines 63-65.

For at least this reason, applicants request reconsideration and withdrawal of the rejection of claim 38 and its dependent claim 61.

Claims 57, 58, and 60, which depend from claim 20, have been rejected as being unpatentable over Obenchain (U.S. Patent No. 5,195, 541). Obenchain does not describe or suggest introducing fluid into a distensible organ, as now claimed in claim 20. Rather, Obenchain describes injecting irrigating fluids into a surgical site located in a disc of a spinal column through device conduits 55, 57 and 59. See col. 1, lines 5-15; col. 4, line 34 to col. 5, line 39. For at least this reason, applicants request reconsideration and withdrawal of the rejection of claims 57, 58, and 60.

Independent claims 39 and 49, and their dependent claims 40-42, 46-48, 50-52, 56, 62 and 65, have been rejected as being anticipated by Bacich (U.S. Patent No. 5,749,889). Claims 63, 64, 66, and 67, which depend from claims 39 and 49, have been rejected as being unpatentable over Bacich.

Claim 39, as amended, recites “inserting a cutter into a lumen of an endoscope through a valve of the endoscope, the lumen having a longitudinal axis extending from the valve to a distal end portion of the endoscope.” Claim 49, as amended, recites “inserting a cutter into a distensible organ through a shut-off valve of an endoscope, the shut-off valve defining an opening for receiving the cutter, the opening being aligned with a longitudinal axis of the endoscope.”

Bacich discloses a secondary port 116 having a valve 166 that may be integrated into an insertion tube of an endoscope. See col. 9, lines 27-31. As shown in Fig. 6 of Bacich, the lumen accessible through the valve 166 would not have a longitudinal axis extending from the valve to a distal end portion of an endoscope (claim 39), and the opening in the valve 166 would not be aligned with a longitudinal axis of an endoscope (claim 49). Rather, the lumen is curved (claim 39), and the valve opening is offset from the longitudinal axis (claim 49).

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claim 39 and its dependent claims 40-42, 46-48, and 62-64, and of claim 49 and its dependent claims 50-52, 56, and 65-67.

Claim 43, which depends from claim 39, has been rejected as being unpatentable over Bacich in view of Obenchain, claims 44 and 45, which depend from claim 39, have been rejected as being unpatentable over Bacich in view of Kimura (U.S. Patent No. 5,749,889), claim 53, which depends from claim 49, has been rejected as being unpatentable over Bacich in view of Obenchain, and claims 54 and 55, which depend from claim 49, have been rejected as being unpatentable over Bacich in view of Kimura. Neither Obenchain nor Kimura remedies the deficiencies of Bacich. In particular, neither Obenchain nor Kimura describes or suggests "inserting a cutter into a lumen of an endoscope through a valve of the endoscope, the lumen having a longitudinal axis extending from the valve to a distal end portion of the endoscope" (claim 39), or "inserting a cutter into a distensible organ through a shut-off valve of an endoscope, the shut-off valve defining an opening for receiving the cutter, the opening being aligned with a longitudinal axis of the endoscope" (claim 49).

Accordingly, for at least the reasons described above with regard to claim 39, applicants request reconsideration and withdrawal of the rejection of claims 43-45 and claims 53-55.

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

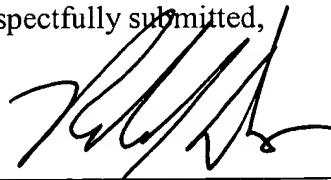
Applicants submit that all claims are in condition for allowance.

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Enclosed is a \$300 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,



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